



09-11-06

Ifu #5

Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)		Application Number	10/617,489
		Filing Date	July 10, 2003
		First Named Inventor	Thomas L. CANTOR
		Art Unit	1641
		Examiner Name	C. Cheu
Total Number of Pages in This Submission	10	Attorney Docket Number	532212000623

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form (1 page plus duplicate)  <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input checked="" type="checkbox"/> Information Disclosure Statement (3 pages)  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Reply to Missing Parts/Incomplete Application  <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____  <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences  <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)  <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):  PTO/SB/08a/b (2 pages plus duplicate); 25 references; Return Receipt Postcard
<div>Remarks</div> <div>CUSTOMER NO.: 25225</div>		

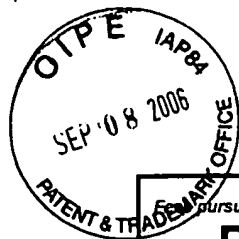
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	Peng Chen		
Date	September 8, 2006	Reg. No.	43,543

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 915 685 933 US, on the date shown below in an envelope addressed to: MS Amendment Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: September 8, 2006

Signature:

(Judy Calam)



Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

PTO/SB/17 (01-06)  
Approved for use through 7/31/2006. OMB 0651-0032  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

<b>FEE TRANSMITTAL</b> <b>For FY 2006</b>		<b>Complete if Known</b>	
		Application Number	10/617,489
		Filing Date	July 10, 2003
		First Named Inventor	Thomas L. CANTOR
		Examiner Name	C. Cheu
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Art Unit	1641
<b>TOTAL AMOUNT OF PAYMENT</b>		<b>(\$)</b>	<b>180.00</b>
		Attorney Docket No.	532212000623

**METHOD OF PAYMENT (check all that apply)**

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_

☒ Deposit Account Deposit Account Number: 03-1952 Deposit Account Name: Morrison & Foerster LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

**FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)**

**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims      Extra Claims      Fee (\$)      Fee Paid (\$)

69      - 101      x      =

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims      Extra Claims      Fee (\$)      Fee Paid (\$)

6      - 6      x      =

HP = highest number of independent claims paid for, if greater than 3.

Multiple Dependent Claims

Fee (\$)      Fee Paid (\$)

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets      Extra Sheets      Number of each additional 50 or fraction thereof      Fee (\$)      Fee Paid (\$)

\_\_\_\_\_ - 100 = \_\_\_\_\_ / 50 \_\_\_\_\_ (round up to a whole number) x \_\_\_\_\_ = \_\_\_\_\_

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1806 Submission of an Information Disclosure Statement      180.00

<b>SUBMITTED BY</b>			
Signature		Registration No. (Attorney/Agent)	43,543
Name (Print/Type)	Peng Chen	Telephone	(858) 720-5117
		Date	September 8, 2006



I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 915 685 933 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: September 8, 2006

Signature:

  
(Judy Calem)

Patent  
Docket No. 532212000623

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Thomas L. CANTOR et al.

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

## SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97 & 1.98

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.97 and § 1.98, Applicants submit for consideration in the above-identified application the documents listed on the attached Form PTO/SB/08a/b. Copies of the documents are also submitted herewith. The Examiner is requested to make these documents of record.

Document numbers 7-14 are from the Reexamination proceeding of U.S. Patent No. 6,030,790, having Control No. 90/007,412. Document numbers 15-18 are updated court dockets downloaded from PACER for the litigation matters that the patent owner is a party. Document numbers 19 and 20 are from *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, currently pending in the United States Court of Appeals for

sd-334244

09/13/2006 RMEBRIGHT 00000032 031952 10617489

01 FC:1806 180.00 DA

the Federal Circuit, Case No. 06-1443. Document number 21 is from *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory Inc. and Scantibodies Laboratory, Inc.*, U.S.D.C. for the Southern District of California, Case No. 02 CV 0046 B (LAB), currently on appeal at the United States Court of Appeals for the Federal Circuit, Case No. 06-1087. Document numbers 22-25 are from the Reexamination proceeding of US Patent No. 6,689,566, having Control Numbers 90/007,685 and 90/007,732. The present application is a Continuation-in-Part (CIP) of US Patent No. 6,743,590, which is a CIP of US Patent No. 6,689,566.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
  - ☐ A fee is required. A check in the amount of \_\_\_ is enclosed.
  - ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly; no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of \_\_\_ is enclosed.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

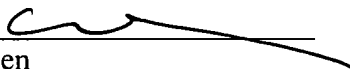
Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

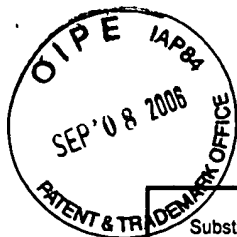
The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 532212000623.

Dated: September 8, 2006

Respectfully submitted,

By   
Peng Chen  
Registration No.: 43,543  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive, Suite 100  
San Diego, California 92130-2040  
(858) 720-5117



ALTERNATIVE TO PTO/SB/08a/b (07-05)

Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>			<b>Complete if Known</b>		
			Application Number	10/617,489	
			Filing Date	July 10, 2003	
			First Named Inventor	Thomas L. CANTOR	
			Art Unit	1641	
			Examiner Name	C. Cheu	
Sheet	1	of	2	Attorney Docket Number	532212000623

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number Number-Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>

\*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS				
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.		T <sup>2</sup>
	1.	JENSEN et al., Clinical Chemistry (1996) 42(6):S172 Abstract 320 "Comparing Specificity For Intact Human Parathyroid Hormone Between INCSTAR PTHSP and Nichols Intact PTH Assays"		
	2.	D'AMOUR, Kidney International (2006) 70:S29-S33		
	3.	D'AMOUR et al., Kidney International (2005) 68:998-1007		
	4.	GARDELLA et al., J. Biol. Chem. (1995) 270:6584-6588		
	5.	HUAN et al., J. Am. Soc. Nephrol. (2006) 17:1923-1930		
	6.	KUNII and VIEIRA, Braz. J. Med. Biol. Res. (2001) 34(12):1547-1550		
	7.	Amendment and Reply Under 37 C.F.R. § 1.116, filed July 10, 2006, from the Reexamination of U.S. Patent No. 6,030,790, Control No. 90/007,412		
	8.	Ex Parte Reexamination Advisory Action, mailed August 3, 2006		
	9.	Communication and Request For An Interview, filed August 8, 2006		
	10.	Petition For An Extension of Time, filed August 8, 2006		
	11.	Statement of Substance of Interview Under 37 CFR § 1.560(b), filed August 9, 2006		
	12.	Miscellaneous Communication, filed August 11, 2006		
	13.	Amendment and Reply Under 37 CFR 1.116 and Statement of Substance of Interview Under 37 CFR § 1.560(b), filed August 16, 2006		
	14.	Ex Parte Reexamination Interview Summary, mailed August 16, 2006		
	15.	Court Docket from PACER for Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc., from the US District Court for the Southern District of California, docket accessed September 8, 2006 (for 2006 dates only)		
	16.	Court Docket from PACER for Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc., from the US Court of Appeals for the Federal Circuit, Case No. 06-1087, docket accessed September 8, 2006		
	17.	Court Docket from PACER for Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical		

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

sd- 334212

Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>				<b>Complete if Known</b>	
				Application Number	10/617,489
				Filing Date	July 10, 2003
				First Named Inventor	Thomas L. CANTOR
				Art Unit	1641
				Examiner Name	C. Cheu
Sheet	2	of	2	Attorney Docket Number	532212000623

		Laboratory, Inc., from the US Court of Appeals for the Federal Circuit, Case No. 06-1443, docket accessed September 8, 2006	
	18.	Court Docket from PACER for Scantibodies Laboratory, Inc., v. Immutopics, Inc., from the US District Court for the Central District of California, docket accessed September 8, 2006	
	19.	Appellant Nichols Institute of Diagnostics, Inc.'s Opening Brief, US Court of Appeals for the Federal Circuit, Case No. 06-1443, filed August 22, 2006	
	20.	Appellant Nichols Institute of Diagnostics, Inc.'s Corrected Opening Brief, US Court of Appeals for the Federal Circuit, Case No. 06-1443, filed August 30, 2006	
	21.	Transcription of the August 9, 2006 Oral Argument, US Court of Appeals for the Federal Circuit, Case No. 06-1087	
	22.	Office Action in Ex Parte Reexamination of US Patent No. 6,689,566, Control No.'s 90/007,685 and 90/007,732, mailed on May 24, 2006	
	23.	Ex Parte Reexamination Interview Summary, June 5, 2006	
	24.	Ex Parte Reexamination Interview Summary, July 10, 2006	
	25.	Amendment in Response to Non-Final Office Action (and Exhibits 1-12 and Replacement Sheet Figure 5), filed in the Ex Parte Reexamination of US Patent No. 6,689,566, Control No.'s 90/007,685 and 90/007,732, filed on July 24, 2006	

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--